REMARKS

Applicant thanks the Examiner for the interview on April 3, 2008. The office action issued by the Examiner and the citations referred to in the office action have been carefully considered. Reconsideration is respectfully requested.

Claims 1, 3-5, 8-10, 12, 14, 17-18, 25 and 43 were rejected under U.S.C. 103(a) as obvious over Dodds (U.S. Pat. 6,287,254) in view of Trendelenburg (Clinica Chimica Acta, 1998, Vol. 278, p. 229-242).

The claims respectfully are patentable over those references.

Clarification has been added to the claims 1, 10 and 25 confirming the selection of the icons to generate and supplemental report. No new matter is added by this clarification. This feature has always been before the Examiner and is merely a clarification of the claimed process as understood by the Examiner. Claim 25 has always dealt with generating a supplemental report. Further the "wherein" terminology in claims 1, 10 and 25 has been replaced with active method steps. No new issue arises from this. These features were always active method steps, for instance in claim 25 since this claim required the generation of a supplemental diagnostic report, and they have thus previously been before the Examiner.

All the independent claims require the characteristics of the icons are defined as being such as to be representative of the textual content of the supplementary report. Further, different icons are individually related to animal characteristics of age and animal grouping.

Claims 1, 10 and 25 include having the icons be for animal characteristics dependant on age and sex, and animal characteristics dependant on animal grouping, and disease state, and wherein the icons are for groupings of at least three of the following animal groups, namely adult, puppy-adolescent, geriatric, or large breed dog.

Additionally the icons <u>are selected</u> for a disease state, being thyroid disease, the icons being representative of being normal relative to thyroid disease, and abnormal relative to thyroid disease. Further these claims indicate that the second computer program is configured to permit supplementation of the data from the first computer program.

Claims 40 to 42 cover the groupings for all of adult, puppy-adolescent, geriatric, or large breed dog respectively.

Claims 43 to 45 cover an icon for a disease state requiring treatment for thyroid disease and for an indication of thyroid autoantibody.

Claims 1, 10 and 25 define an invention which is clearly patentable over the prior art.

The independent claims require that:

- the second computer program includes icons defining predetermined supplemental report characteristics
- selected icons may <u>be selected</u> and used to supplement the laboratory report
- the icons are for animal characteristics dependant on age and sex, and animal characteristics dependant on animal grouping
- the icons are for groupings of at least three of the following animal groups, namely adult, puppy-adolescent, geriatric, large breed dog, or sight hound
- icons for a disease state, being thyroid disease
- the icons being representative of being normal relative to thyroid disease, and abnormal relative to thyroid disease
- the icons are defined as being such as to be representative of the textual content to be added to the supplementary report
- different icons are individually related to animal characteristics of age and animal grouping.

The references do not remotely relate to the features of the present invention.

They do not relate to obtaining, and generating reports and electronically delivering a **diagnosis of the health of an animal** through a combination of computerized data and human interpretation where data relating to the physical characteristics of the animal using the icon system of the invention.

The data is obtained from a physical inspection and family and breed history of the animal given to a clinical pathologist.

A computer generated report of the laboratory analysis reports the computer analysis to a clinical pathologist. The clinical pathologist has the data relating to the physical characteristics, and thereby makes a diagnosis of the animal health by human interaction. The icons are selected and used to supplement the laboratory report.

A **supplemental diagnostic report** to support the diagnosis is generated and obtained.

An enhanced report may be generated and obtained by a further input from the pathologist through data entry.

The integrated computer report having the laboratory analysis, **supplemental**, and an **enhanced diagnostic report** is all electronically communicated to a remotely located client.

There are multiple levels of activity which are spelt out, in the claims These are not remotely disclosed, taught or suggested by the references. Nowhere are the steps of the main laboratory and activities of the clinical pathologist even considered in the references. Nowhere are the different levels of report considered. Nowhere are the animal characteristics, even part of the references.

Even more so, in respect of there is the need for securing a blood sample from the animal and submitting the blood sample for laboratory analysis. This is not disclosed, taught or suggested in the references.

The **diagnosis** of the health of an animal is through a combination of computerized data and human interpretation related to the animal which requires obtaining data relating to the physical characteristics of the animal, the data being obtained from a physical inspection and family and breed history of the animal, and the data submitted to a clinical pathologist; and blood sample being laboratory analyzed.

The invention is concerned with obtaining at least four input data so that thereafter there can be an interpretation by a combination of computerized data and human interaction.

The data is obtaining relating to the physical characteristics of the animal, and thus the data is obtained from a physical inspection and family history of the animal. The data is submitted to a clinical pathologist.

A computer generated report of the laboratory analysis from the laboratory is sent through a network to a clinical pathologist. The icons are selected and used. The clinical pathologist has the data relating to the physical characteristics, and thereby makes a diagnosis of the animal health as a generated and an enhanced diagnostic report. This is communicated electronically to a remotely located client.

There is a method of obtaining and electronically delivering a diagnosis of the health of an animal through a combination of computerized data and human interpretation related to the animal.

None of the cited art relates to animal disease diagnosis with characteristics unique to animals, as indicated in each of these independent claims. Hence human type prior art systems are not relevant and do not teach features necessary for animal disease diagnosis as claimed. Thus, the cited references are not appropriate prior art.

Trendelenburg deals with icons which are of a nature such as the conventional Microsoft Access program which is a conventional database program which uses icons of cut, paste, print or save etc. Cut, paste, print or save etc icons are not per se representative of the textual content of a report-they are simply empty icons or a short cut to effect an instruction. There is no per se textual content represented in the Trendelenburg icons and likewise none can be presumed. There is clearly no disclosure, teaching or suggestion in Trendelenburg of icons defined as being representative of the textual content to be added to the supplementary report. Also the different icons are individually related to animal characteristics of age and animal grouping. Accordingly

Trendelenburg is deficient in multiple respects in regard to the nature of the icons as presently claimed.

Clearly also in relation to the claims 40-45 there is no disclosure teaching or suggestion in Trendelenburg of icons indicated to be representative of textual information related to or representing diagnostic interpretation.

Dodds is a system of relating different phenotype and genotype characteristics in an assessment of a disease. There is nothing remotely disclosed about doing a supplemental report or an enhanced report, nor any thing about icons of any nature. Dodds does not disclose or suggest an icon or a GUI, and hence not even remotely an icon representative of the textual content to be added to the supplementary report .

The Examiner admits that Dodds does not teach a supplemental or enhanced report or a second computer program comprising menus and icons. The Examiner contends that the alternative embodiment of data interpretation performed by algorithm and outputted to a user via an expert interface suggests additional reports generated using a second program and GUIs.

This is specifically rebutted by the inventor Dodds. A declaration from the inventor Dodds (of US 6,287,254) and the present application states diametrically opposite to the Examiner's unsupported conclusion. Exhibit A. Dodds is not a disclosure, teaching or suggestion of the present invention, and nor would it have been obvious to modify the teachings of Dodds or to be obvious to try from her knowledge at the time to obtain the features of the present invention, namely the function generated icons from her knowledge at the time the present invention was made.

Furthermore the independent claims additionally require that <u>the icons be used --they are functional and they carry weight in the claims</u> as follows :

- the second computer program includes icons defining predetermined supplemental report characteristics
- <u>selected icons may be used</u> to supplement the laboratory report

- the icons are used for animal characteristics dependant on age and sex, and animal characteristics dependant on animal grouping
- the icons are used for groupings of at least three of the following animal groups, namely adult, puppy-adolescent, geriatric, large breed dog, or sight hound.
- icons are used for a disease state, being thyroid disease
- the icons are representative of being normal relative to thyroid disease and abnormal relative to thyroid disease
- the icons are defined as being such as to be representative of the textual content to be added to the supplementary report
- different icons are individually related to animal characteristics of age and animal grouping

In view of the above, it is submitted that the claims as presented are patentable over the cited art.

REJECTION UNDER 35 U.S.C. § 103(A)

1.   KSR Applies to the Instant Application

The responsive arguments presented by the Applicants throughout the prosecution history were based on the teaching, suggestion, motivation test promulgated by United States Court of Customs and Patent Appeals and adopted by the Federal Circuit. *Application of Bergel*, 292 F.2d 955, 956-957, 48 C.C.P.A. 1102, 1961 Dec. Comm'r Pat. 504 (1961). The Applicants recognize, however, that the current authority on matters of obviousness must square with the Supreme Court's recent decision in *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007). Accordingly, although the teaching, suggestion, motivation test is still recognized under *KSR*, the test is largely subsumed by the more general principles laid out in *KSR*. Indeed, in any given application, the combination of elements "must do more than yield a predicable result." *Id.* at 1740. Nevertheless, combining elements "in an unexpected and fruitful manner" is sufficient to render an invention non-obvious. *Id.*

2.   The Combination of References Used by the Examiner is Improper

The claims have been rejected over an improper combination of references by the Examiner. *KSR* provides guidance with respect to the combination of references used to reject a patent application on the ground of obviousness. According to *KSR*: "Although **common sense** directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, **it can be important to identify a reason** that would have **prompted** a person of ordinary skill in the relevant field **to combine the elements** in the way the claimed new invention does." *KSR* at 1741 (emphasis added).

More importantly, "a patent composed of several elements **is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.**" *Id.* (emphasis added).

In *KSR*, the Supreme Court addressed such logic in obviousness-type rejections. Importantly, *KSR* specifically forbids obviousness rejections simply because each element was independently known in the prior art. The art cited against the instant application falls into this rubric because they are nothing more than a string of unrelated references showing each of the claimed elements with tenuous logic to support their combination. The Examiner has failed in his burden to explain any compelling reason why a person of ordinary skill would have combined these references.

3.   No Reasonable Expectation of Success Can Be Inferred from the Combination of References Asserted by the Examiner

        a.   Reasonable Expectation Standard Reaffirmed Post-*KSR*

The Federal Circuit stated "obviousness does not require absolute predictability of success . . . [a]ll that is required is a reasonable expectation of success." *In re O'Farrell*, 853 F.2d 894, 903-04; 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988). Thus, if a reasonable expectation of success is derived from a reference or combination of references, an invention may be rendered

obvious. Conversely, where no reasonable expectation of success is derived, an obviousness rejection is improper. *Id.*

More specifically, *O'Farrell* provides general guidance as to when an invention falls under the reasonable expectation of success rubric, which was subsequently reaffirmed by the Federal Circuit post-*KSR* in *Pharmastem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342, 1364; 83 U.S.P.Q.2d 1289 (Fed. Cir. 2007). According to the Federal Circuit, "an invention would not be invalid for obviousness if the inventor would have been motivated 'to **vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result**, where the **prior art gave** either **no indication** of which parameters were critical or **no direction** as to which of many possible choices is likely to be successful.'" *Id.* at 1364, *quoting Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165, 77 U.S.P.Q.2d 1865 (Fed. Cir. 2006) (emphasis added).

In a secondary test posited by the Federal Circuit in *Pharmastem*, the court stated "[l]ikewise, an invention would **not be deemed obvious** if **all that was suggested** 'was to **explore a new technology or general approach** that seemed to be a **promising field of experimentation**, where the **prior art gave only general guidance** as to the particular form of the claimed invention or how to achieve it.'" *Id.*, *quoting Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165, 77 U.S.P.Q.2d 1865 (Fed. Cir. 2006) (emphasis added).

      b.   No Reasonable Expectation of Success Where Numerous Possible Choices or Requirement to Vary All The Parameters

Using the first of the standards promulgated by the Federal Circuit, the combination of references cited by the Examiner against the claims have no reasonable expectation of success because the prior art references give no indication of critical parameters or direction as to how to achieve the claimed invention. Using any one of the prior art as the starting point to arrive at the claimed references cited against the instant application would require numerous choices in direction and experimentation, as well as variance of many parameters to arrive at the claimed invention.

For the reasons stated above, the prior art references cited against the claims also fail the second standard promulgated by the Federal Circuit. An invention is not obvious if all that was suggested is to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. *Pharmastem* at 1364. In other words, the combination of references must give specific guidance to arrive at the claimed invention.

More specifically, the prior art references cited against the instant claims include references directed to different fields. These prior art references alone do not even provide even general guidance to the instant problem and claimed solution.

In fact, the combination of these references makes sense **only** when viewed in the context of the specification and claims. Alone, they don't get a person of ordinary skill in the art any closer to an expectation of success because they simply don't have any guidance, even when combined, to guide a person of ordinary skill in the art to the claimed result without significant detective work. Further as indicated there is not even the remotest disclosure or suggestion of an icon or a GUI representative of the textual content to be added to the supplementary report .

More so, a Declaration for the inventor Dodds, and expert in the field of veterinary diagnostics and reporting is included in support of the inventive aspects of the present invention.

The invention provides an important advance in the field of blood testing for animals and the overall manner of providing supplemental and enhanced reporting. The use of icons are for being representative of the textual content of the supplementary report or different icons are individually related to animal characteristics of age and animal grouping.

It is respectfully submitted that all of the Examiner's objections have been successfully traversed and that the application is now in order for allowance. Accordingly, reconsideration of the application and allowance thereof is courteously solicited.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to **Deposit Account Number 50-2638**. Please ensure that Attorney Docket Number 058034-011800 is referred to when charging any payments or credits for this case.

Respectfully submitted,

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